

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant :	Michael Bardroff et al.	Art Unit :	1649
Patent No. :	7,794,719	Examiner :	Gregory S. Emch
Issue Date :	September 14, 2010	Conf. No. :	1924
Serial No. :	10/505,313		
Filed :	March 7, 2005		
Title :	ANTI-AMYLOID BETA ANTIBODIES		

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

APPLICATION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705(d)

Patentees hereby request reconsideration of the Patent Term Adjustment (PTA) accorded the above-referenced patent. Reconsideration of the final PTA calculation to increase total PTA from 1016 days to 1412 days is respectfully requested.

“A Delays” are defined as delays by the U.S. Patent and Trademark Office (PTO) under 35 U.S.C. § 154(b)(1)(A), which guarantees prompt PTO response. “B Delays” are defined as delays by the PTO under 35 U.S.C. § 154(b)(1)(B), which guarantees no more than three year application pendency.

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

“A Delay”

A first PTO action was due on or before May 7, 2006 (the date that is fourteen months after March 7, 2005, the date on which the application fulfilled the requirements of 35 U.S.C. § 371). The PTO mailed the first non-final Office Action on June 5, 2007, thereby according a PTO Delay of 394 days. See 37 C.F.R. §§ 1.702(a)(1) and 1.703(a)(1). Patentees do not dispute the PTO’s calculation for this “A Delay.”

Patent issuance was due on or before March 2, 2010 (the date that is four months after November 2, 2009, the date on which the issue fee was paid). The PTO issued a patent on September 14, 2010, thereby according a PTO Delay of 196 days. See 37 C.F.R. §§ 1.702(a)(4) and 1.703(a)(6). Patentees do not dispute the PTO’s calculation for this “A Delay” from

**CERTIFICATE OF MAILING BY EFS-WEB FILING**

I hereby certify that this paper was filed with the Patent and Trademark Office using the EFS-WEB system on this date: November 12, 2010.

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March 3, 2010 (the day after the date that is four months after the date on which the issue fee was paid), to September 14, 2010.

In view of the period of "A Delay" detailed above, the total "A Delay" for this patent should be calculated as 590 days.

#### "B Delay"

The present application is a national stage filing under 35 U.S.C. § 371 of international application number PCT/EP2003/001759, filed February 20, 2003, which claims the benefit of priority of European Application number 02003844.4, filed February 20, 2002.

The national stage for the present application "commenced" under the provisions of 35 U.S.C. § 371(b), i.e., upon expiration of 30 months from the priority date of the international application. As a result, the date that the national stage commenced was August 20, 2004 (i.e., 30 months from the priority date of February 20, 2002).

The period beginning on August 21, 2007 (the day after the date that is three years after August 20, 2004, the date that the national stage commenced), and ending September 14, 2010 (the date the patent was issued), is 1121 days in length. The total "B Delay" for this patent is calculated as 1121 days. Patentees do not dispute the PTO's calculation for this "B Delay" from August 21, 2007, to September 14, 2010.

#### Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:

May 8, 2006, to June 5, 2007; and,  
March 3, 2010, to September 14, 2010.

As detailed above, "B Delay" accumulated during the following period:

August 21, 2007, to September 14, 2010.

As such, the periods of "A Delay" and "B Delay" overlap (i.e., occur on the same calendar day) for a total of 196 days, from March 3, 2010, to September 14, 2010.

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## Applicant Delay

### (1) Points of Agreement with PTO Applicant Delay Calculation

#### (a) Supplemental Response

Patentees filed an Information Disclosure Statement on August 6, 2007, subsequent to a reply filed on July 27, 2007. Patentees were accorded a delay of 10 days for a supplemental response. See 37 C.F.R. § 1.704(c)(8). Patentees do not dispute the PTO's calculation for this Applicant Delay from July 28, 2007, to August 6, 2007.

#### (b) Supplemental Response

Patentees filed an Information Disclosure Statement on November 13, 2007, subsequent to a reply filed on October 25, 2007. Patentees were accorded a delay of 19 days for a supplemental response. See 37 C.F.R. § 1.704(c)(8). Patentees do not dispute the PTO's calculation for this Applicant Delay from October 26, 2007, to November 13, 2007.

#### (c) Late Reply to Office Action

A reply to an Office Action was due on or before April 28, 2008 (the date that is three months after January 28, 2008, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on July 2, 2008. Patentees were accorded an Applicant Delay of 65 days. See 37 C.F.R. § 1.704(b). Patentees do not dispute the PTO's calculation for this Applicant Delay.

#### (d) Supplemental Response

Patentees filed an Information Disclosure Statement on January 21, 2009, subsequent to a reply filed on January 16, 2009. Patentees were accorded a delay of 5 days for a supplemental response. See 37 C.F.R. § 1.704(c)(8). Patentees do not dispute the PTO's calculation for this Applicant Delay from January 17, 2009, to January 21, 2009.

(e) Late Reply to Office Action

A reply to an Office Action was due on or before July 29, 2009 (the date that is three months after April 29, 2009, the date on which the Office Action was mailed). Patentees filed a response to the Office Action on July 31, 2009. Patentees were accorded an Applicant Delay of 2 days. See 37 C.F.R. § 1.704(b). Patentees do not dispute the PTO's calculation for this Applicant Delay.

(2) Points of Disagreement with PTO Applicant Delay Calculation

(a) Errors in Applicant Delay Calculation Addressed in Petition Under 37 C.F.R. § 1.181 filed on August 20, 2010

(i) Notice of Non-Compliant Amendment

A reply to a Notice of Non-Compliant Amendment was due on or before January 18, 2008 (the date that is three months after October 18, 2007, the date on which the Notice was mailed). Patentees filed a response to the Notice on October 25, 2007, and were accorded an Applicant Delay of 80 days (90 days reduced by 10 days of overlapping Applicant Delay), ostensibly under 37 C.F.R. § 1.704(c)(8), in the Office's Decision on Application for Patent Term Adjustment mailed June 22, 2010. Patentees respectfully submit that this calculation of Applicant Delay contains an error and that the correct calculation of Applicant Delay associated with this filing is 0 days. A Petition Under 37 C.F.R. § 1.181 to Invoke the Supervisory Authority of the Director, to which the Office has not yet responded, was filed on August 20, 2010, to request reconsideration of this calculation of Applicant Delay.

(ii) Notice of Non-Responsive Amendment

The Office mailed a Notice of Non-Responsive Amendment on October 14, 2008, in which it improperly asserted that Patentees' submissions on July 2, 2008, and July 28, 2008, were not responsive. Patentees filed a response to the Notice on January 16, 2009, and were assessed an Applicant Delay of 198 days under 37 C.F.R. § 1.704(c)(7). Patentees respectfully submit that this calculation of Applicant Delay contains an error and that the correct calculation of Applicant Delay associated with this filing is 2 days, from January 15, 2009 (the day after the date that is three months from the date on which the Notice was mailed) to January 16, 2009 (the date on which the response was filed). A Petition Under 37 C.F.R. § 1.181 to Invoke the Supervisory Authority of the Director, to which the Office has not yet responded, was filed on August 20, 2010, to request reconsideration of this calculation of Applicant Delay.

(b) New Error in Applicant Delay Calculation Subsequent to Notice of Allowance

Request for Reconsideration of Patent Term Adjustment

The Office mailed a Notice of Allowance and Fees Due including a Determination of Patent Term Adjustment under 35 U.S.C. § 154(b) on August 21, 2010. On October 16, 2010, Patentees timely filed an application for patent term adjustment under 37 C.F.R. § 1.705(b). No other filing was made on that date. On line 95 of the Patent Term Adjustments tab of the PAIR/PALM system, an "Amendment after Notice of Allowance (Rule 312)" is entered as having been filed on October 16, 2010, and an Applicant Delay of 120 days was accorded in connection with this entry. Patentees respectfully submit, however, that no such amendment was filed; rather, it appears that the documentation submitted in support of the Request for Reconsideration was inappropriately coded as an amendment in the Patent Term Adjustments tab.

37 C.F.R. 1.704(e) explicitly indicates that "[s]ubmission of an application for patent term adjustment under [37 C.F.R.] § 1.705(b) (with or without request under § 1.705(c) for reinstatement of reduced patent term adjustment) will not be considered a failure to engage in

reasonable efforts to conclude prosecution (processing or examination) of the application under paragraph (c)(10) of this section.” Because no filing other than an application for patent term adjustment (and its associated supporting documentation) was filed on October 16, 2010, Patentees respectfully submit that the calculation of 120 days of Applicant Delay is incorrect and that the correct calculation of Applicant Delay associated with this filing is 0 days.

### (3) Summary of Proper Applicant Delay Calculation

In view of the periods of Applicant Delay detailed above, the total Applicant Delay for this patent should be calculated as 103 days (i.e., the sum of 10 days, 19 days, 65 days, 2 days, 5 days, and 2 days).

### Terminal Disclaimer

This patent is not subject to a terminal disclaimer.

### Conclusion

In consideration of the events described above, Patentees believe the PTA calculation of 1016 days is incorrect. As such, Patentees respectfully request reconsideration of the PTA in the following manner:

- 1) Total PTO Delay should be calculated as 1515 days (i.e., the sum of 590 days of “A Delay” and 1121 days of “B Delay,” minus 196 days of overlapping “A Delay” and “B Delay”);
- 2) Total Applicant Delay should be calculated as 103 days; and
- 3) Total PTA should be calculated as 1412 days.

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The fee of \$200 required under 37 C.F.R. § 1.18(e) is being paid concurrently herewith on the Electronic Filing System (EFS) by way of Deposit Account Authorization. Please apply any other required charges or credits to Deposit Account No. 06-1050, referencing Attorney Docket No. 25442-0006001.

Respectfully submitted,

Date: November 12, 2010

/Jack Brennan/

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